

REMARKS

Claims 1 through 14 and 16 through 19 are pending in this Application of which claims 1 through 11 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 12 through 14 and 16 through 19 are active.

Claim 12 has been amended by incorporating the limitations of claims 15 and 20, indicated allowable, therein, and claims 15 and 20 canceled. Applicants submit that the present Amendment does not generate any new matter issue or any new issue for that matter. Moreover, the present Amendment clearly places the application in condition for allowance. Indeed, the present Amendment at least reduces the number of issues, for reasons expressed *infra* and, hence, clearly places the Application in better condition for Appeal. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are solicited pursuant to the provisions of 37 C.F.R. § 1.116.

Telephonic Interview of February 3, 2005

Applicants acknowledge, with appreciation, Examiner Lindsay's courtesy in conducting a telephonic interview on February 3, 2005. During that telephonic interview, Examiner Lindsay agreed that the present Amendment would place the Application in condition for allowance. The following comments are added for completeness.

Claims 12 through 15 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Alluri et al. in view of Cheung.

This rejection is traversed. Applicants note that the limitations of claim 20 have been incorporated into independent claim 12, and claim 20 canceled. The Examiner indicated that claim 20 contained allowable subject matter.

Applicants would stress that, for the reasons expressed in the responsive Amendment submitted November 16, 2004, one having ordinary skill in the art would not have been realistically motivated to modify the semiconductor device disclosed by Alluri et al. by providing a silicon-rich silicon oxide layer having an RI greater than 1.6 as specified in claim 12 prior to the present Amendment. At any rate, in order to expedite prosecution, claim 12 has been amended by incorporating the limitations of claim 20 therein, thereby requiring the silicon-rich silicon oxide layer to be substantially opaque to UV radiation. This concept is neither disclosed by Alluri et al. or Cheung. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the **claimed invention** would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 12 through 15 under 35 U.S.C. § 103 for obviousness predicated upon Alluri et al. in view of Cheung is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 16 through 19 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Alluri et al. in view of Cheung, Weimer and Wolf et al.

This rejection is traversed. Specifically, claims 16 through 19 depend from independent claim 12. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 12 under 35 U.S.C. § 103 for obviousness predicated upon Alluri et al. in view of Cheung. The additional references to Weimer and Wolf et al. do not cure the previously argued deficiencies in the attempted combination of Alluri et al. and Cheung. Ergo, even if the applied references are combined as suggested by the Examiner, and Applicants do not

agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Applicants, therefore, submit that the imposed rejection of claims 16 through 19 under 35 U.S.C. § 103 for obviousness predicated upon Alluri et al. in view of Cheung is not factually or legally viable and, hence, solicit withdrawal thereof.

The Reference to Hui et al. (U.S. Patent No. 6,833,581)

In the Advisory Action dated February 25, 2005, the Examiner brought to Applicants' attention U.S. Patent No. 6,833,581 (Hui et al.). Applicants note that the UV radiation blocking layer disclosed by Hui et al. has a thickness between 1,500Å and 2,000Å; whereas, the thickness of the UV blocking layer specified in independent claim 12 is between 400Å and 600Å. During the telephonic interview of March 3, 2005, Examiner Lindsay agreed that the present Amendment would, therefore, not be vulnerable to a rejection predicated upon Hui et al.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/617,451

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: March 7, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**